

REMARKS

The Office Action asserts that the Amendment filed on June 6, 2008, “proposes amendments to [the claims] that [purportedly] do not comply with 37 CFR [§] 1.173(b), which sets forth the manner of making amendments in reissue applications,” and the Office Action requires submission of a supplemental amendment paper. In addition, the Office Action notes that “for changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g., claims 8, 11-12, 18, 30, 33-34, 43, 55, 78, 83-84, 86-87, [and] 90-91.”

As explained in more detail below, Applicant respectfully submits that the claim amendments in the Amendment filed on June 6, 2008, fully comply with 37 C.F.R. § 1.173(b). Since the claim amendments are in full compliance with Rule 173(b), Applicant respectfully requests either a withdrawal of the requirement for a supplemental amendment paper or a more detailed explanation of why the Office has objected to the previously submitted claim amendments.

The rule cited in the Office Action, 37 C.F.R. § 1.173(b), states that in an amendment paper, “[e]ach changed patent claim [i.e., each claim appearing in the original patent] and each added claim [i.e., each claim that does not appear in the original patent] must include markings pursuant to [37 C.F.R. § 1.173(d)].” 37 C.F.R. § 1.173(b)(2). Rule 173(d), which is referenced in Rule 173(b), specifies that “[a]ny changes **relative to the patent being reissued** which are made to . . . the claims . . . by an amendment paper in [a] reissue application, must include . . . (1) . . . brackets [identifying subject matter being omitted by reissue]; and . . . underlining [identifying subject matter being added by reissue].” 37 C.F.R. § 1.173(d) (Emphasis supplied).

Further, 37 C.F.R. § 1.173(g) requires that “[a]ll amendments [to the claims] must be made **relative to the patent . . . claims** . . . which are in effect as of the date of filing of the reissue application.” (Emphasis supplied). As explained in M.P.E.P. § 1453(IV), “[a]ll amendments subsequent to the first amendment [submitted in a reissue application] must . . . be made relative to the patent specification [including the claims] in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment. (Emphasis in original).

The M.P.E.P. at § 1453(V)(D) explains that “[a]n amendment of a ‘new claim’ (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended ‘new claim’ containing the amendatory material, and completely underlining the claim[;] [t]he presentation cannot contain any bracketing or other indication of what was in the previous version of the claim.”

Applicants respectfully submit that all of the claim amendments in the Amendment filed on June 6, 2008, comply with the above-mentioned rules and M.P.E.P. provisions. In the June 6, 2008 Amendment, amended claims 8, 11, 12, and 18 are claims of the original patent (U.S. Patent No. 6,089,410), and amended claims 30, 33-34, 43, 55, 78, 83, 84, 86, 87, 90, and 91 are amended “new claims” relative to the patent (i.e., they do not appear in U.S. Patent No. 6,089,410). Each of amended claims 8, 11, 12, and 18 in the Amendment includes brackets to show deletions and underlining to shown additions with respect to the original patent, as required by 37 C.F.R. § 1.173(b),(d), and (g). See M.P.E.P. § 1453(V)(A)(Example (2)). In accordance with M.P.E.P. 1453(V)(D), quoted above, each of amended new

claims 30, 33-34, 43, 55, 78, 83, 84, 86, 87, 90, and 91 is "completely underlin[ed]" and, because these amended new claims "cannot contain any bracketing or other indication of what was in the previous version of the claim" (M.P.E.P. § 1453(V)(D)), these amended new claims do not contain any bracketing or indicators other than the complete underlining.

For at least these reasons, Applicant respectfully submits that the claim amendments in the Amendment filed on June 6, 2008, fully comply with 37 C.F.R. § 1.173(b). Since the claim amendments are in full compliance with Rule 173(b), Applicant respectfully requests the Examiner to withdrawal the requirement for a supplemental amendment paper. If, however, the Examiner maintains such a requirement, Applicant respectfully requests a more detailed explanation of why the Office has objected to the previously submitted claim amendments, and an indication of the specific content required for any such supplemental amendment paper.


If a telephone conversation would expedite prosecution of the application, the Examiner is invited to contact Applicant's counsel (571 203 2774).

Please grant any extensions of time required to enter this response and charge any required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 30, 2009

By: 
Anthony M. Gutowski
Reg. No. 38,742